

In re Patent Application of:
OLOFSSON ET AL.
Serial No. 09/582,637
Filed: October 20, 2000

transmission on a subscriber line. Independent Claim 63 is directed to a telecommunications system also including such features.

Claims 34-56 and 60-63 were rejected in view of various combinations of Scholtz et al. (U.S. 6,301,337), Dresser (U.S. 5,357,556), Lechleider (U.S. 6,091,713), Bingel (U.S. 6,014,425), Winkler (U.S. 5,870,451), Bella (U.S. 6,278,769; U.S. 6,212,258; U.S. 6,181,775) and/or EP 0790977 for the reasons set forth on pages 2-8 of the Office Action.

No prior art was cited against Claims 57-59.

Applicants contend that Claims 34-56 and 60-63 clearly define over the cited references, and in view of the following remarks, favorable reconsideration of the rejections under 35 U.S.C. §103 is requested.

Initially, Applicants point out that each of the cited Bella patents has an earliest U.S. filing date of November 25, 1998. The present application was filed under 35 U.S.C §371 based upon International Application No. PCT/SE99/00121 filed January 28, 1999 which claims priority of Swedish Application No. 9800249-6 filed January 29, 1998. A certified copy of the Swedish priority application was submitted to the International Bureau under PCT Rule 17.1(a), and receipt of such was acknowledged as evidenced by the PCT/IB/304 filed in the present application. Accordingly,

Bella { Applicants submit that the Bella patents, relied upon by the Examiner, do not qualify as prior art under 35 U.S.C. §102 and §103 and the rejections in view thereof should be properly withdrawn. }

In rejecting independent Claims 34, 46, 49 and 63, the Examiner asserts that the Scholtz et al. patent teaches

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most of the claimed subject matter. While correctly recognizing that the Scholtz et al. patent does not teach or suggest using a unique identity code, the Examiner asserts, without reference to any particular prior art reference, that it is "notoriously well known" in the art to use identification codes including "ANI or CLI" to identify a subscriber loop.

The Scholtz et al. patent is directed to a handset and POTS filter for testing transmission quality of a local loop. (Col. 2, Lines 58-60; Col. 4-Col. 5, Lines 61-2.) But the handset and POTS filter of the Scholtz et al. patent are explicitly related to testing at a subscriber's premises, for example, at the junction box located at the subscriber's home or office. (Col. 2, Lines 60-66; Col. 5, Lines 5-17.) In other words, the purpose of the Scholtz et al. patent is to allow manual on-premise testing by a field technician, and, accordingly, there is no need for a unique identity code to be transmitted with the test signal. A capability for using a unique code in identifying the test handset is irrelevant to the Scholtz et al. patent. Accordingly, there is no suggestion or motivation for the selective combination of the use of automatic number identification with the Scholtz et al. patent. Moreover, even such a selective combination fails to produce the claimed invention.

The Examiner also relies on a selective combination of the Scholtz et al. patent with the Dresser or Lechleider et al. patents in rejecting independent Claims 34, 46, 49 and 63. The Dresser patent is directed to a system and method for testing equipment in a telephone network for remote maintenance and verification of subscriber loops. The system

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and method accommodate known AC and DC fault testing techniques while providing duplex verification of the subscriber loop identification. The Examiner describes the Lechleider et al. patent as teaching generation of a test signal and identification of a subscriber loop through caller ID or ANI information. The Lechleider et al. patent discloses a logic device that places a telephone call, via a modem at a subscriber's premises, to a distant modem at a qualification center. The initial negotiation between the two modems produces information that is used to determine operating conditions that, in turn, are used to determine the viability of deploying ADSL over the subscriber line. The information derived from the modems is described as analog properties, such as power levels, noise levels, loss levels and far-end echo loss.

As the Examiner is aware, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim features. The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the Applicants have done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the reference must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the

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teachings of the reference. Both the suggestion to make the claimed combination and the reasonable expectation of success must be founded in the prior art and not in Applicants' disclosure.

Nowhere, however, does the Dresser or Lechleider et al. patents teach or suggest that the respective devices are combined with, or part of, an active POTS splitter. The Scholtz et al. patent, as noted already, is directed to a handset that can be taken by a technician to a subscriber's premises to perform on-premise testing. In contrast, the Dresser system includes an ID unit located at the local central office, and the Lechleider et al. patent relies on a logic device such as the subscriber's own personal computer, a Set top Box, a Web TV, or any other device already at the subscriber's premises. The logic device communicates via a modem to a service provider at a remote central location so that a determination can be made at the central location as to whether the subscriber loop can support copper-based broadband technology. Accordingly, there is no motivation for selectively combining any of the patents, and indeed, each teaches away from the other.

POTS splitter
which functions
as a tester

motivation
to
Combine

The other cited references are relied upon by the Examiner to teach the use of various line testing features. However, none of these references makes up for the deficiencies of the Scholtz, Dresser and Lechleider references as discussed above.

There is simply no teaching or suggestion in the cited references to provide the combination of features as claimed. Accordingly, for at least the reasons given above, Applicants maintain that the cited references do not disclose

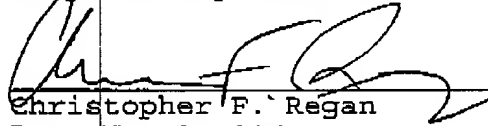
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or fairly suggest the invention as set forth in Claims 34, 46, and 63. Furthermore, no proper modification of the teachings of these references could result in the invention as claimed. In view of their patentability, Applicants submit that their dependent claims, which recite yet additional features of the present invention are also patentable. No further discussion of these claims is therefore necessary.

CONCLUSION

In view of the arguments provided herein, it is submitted that all the claims are patentable. Accordingly, a Notice of Allowance is requested in due course. If any minor informalities need to be addressed, the Examiner is encouraged to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,



Christopher F. Regan
Reg. No. 34,906
Allen, Dyer, Doppelt, Milbrath
& Gilchrist, P.A.
255 S. Orange Avenue, Suite 1401
Post Office Box 3791
Orlando, Florida 32802
407/841-2330

CERTIFICATE OF FACSIMILE

I HEREBY CERTIFY that the foregoing correspondence has been forwarded via facsimile number 703-872-9314 to the Assistant Commissioner for Patents, Washington, D.C. 20231 on this 6th day of November, 2002.

